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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.
08/417,174	04/05/95	KAWAKAMI	Y	2026-4124US1

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EXAMINER	
HUFF,S	

ART UNIT	PAPER NUMBER
1806	13

DATE MAILED: 08/04/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/417,174	Applicant(s) Kawakami et al
	Examiner Sheela J. Huff	Group Art Unit 1806

☒ Responsive to communication(s) filed on *Jun 5, 1997*.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-38* is/are pending in the application.

Of the above, claim(s) *1-14 and 32-38* is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *15-24 and 26-31* is/are rejected.

☒ Claim(s) *25* is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Response to Amendment

1.The amendment filed on 6/5/97 has been considered. Applicant's arguments are deemed to be persuasive-in-part.

Claims 15-31 are currently under consideration. Claims 1-14 and 32-38 are withdrawn from consideration as being drawn to a non-elected invention.

2.The rejections under 35 U.S.C. 112, first paragraph, are withdrawn in view of applicant's amendment.

3.The objection to the claims is withdrawn in view of applicant's amendment.

4.The rejection under 35 U.S.C. 112, second paragraph, is withdrawn in view of applicant's amendments.

Response to Arguments

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 15-16 and 27-28 remain rejected under 35 U.S.C. 102(a) as being anticipated by Maresh et al DNA and Cell Biology vol. 13 p. 87 (2/94). The reasons for this rejection are of record in paper no. 10, mailed 10/30/96.

Applicant argues that the reference does not teach fragments. Claim 15 recites the terminology "within" and it is not clear if "within" is meant to include full-length gp100 of merely fragments.

7. Claims 15-16 and 27-28 remain rejected under 35 U.S.C. 102(b) as being anticipated by WO 92/21767. The reasons for this rejection are of record in paper no. 10, mailed 10/30/96.

Applicant argues that the reference does not disclose the fragment as being recognized by T-lymphocytes. Such a property is inherent in the peptide of the reference.

New Grounds of Rejection

Claim Rejections - 35 USC § 112

8. Claims 15-21 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In claim 15, line 2 it is not clear what applicant means by "within". Is this meant to exclude full-length gp100?

b. In claim 15, line 3, the terminology "recognized by" renders the claim vague and indefinite. Does applicant mean "binds"? "Recognized" merely means that the T-lymphocytes have the ability to bind to the peptide but they do not have to bind to the peptide(ie the peptide can or cannot interact with T-lymphocytes). If applicant intends to use the "recognized" as a functional limitation then more definite terminology (such as binds) is needed.

c. In claim 15 it is noted that applicant has deleted the SEQ ID No. Because there are several names for gp100, such as P-mel and ME20, a specific SEQ ID No. should be recited.

d. Claim 27 depends on non-elected claims.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

10. Claims 22-24, 26-29 and 31 are rejected under 35 U.S.C. 102(a) as being anticipated by Cox et al, Science vol. 264 p. 717 (4/29/94).

This reference discloses the peptide YXEPGPVTA (p. 717, second column) where X is either ile or leu. These peptides are made synthetically. Because the peptide found in the prior art does not appear to be in the parent application, the reference anticipates the claimed invention.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 22-24, 26-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox et al, Science vol. 264 p. 717 (4/29/94).

This reference has been discussed above.

The only difference between the instant invention and the reference is in the treatment of melanomas.

The reference clearly suggests that the peptides can be used in immunotherapy of melanomas.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the peptides of the reference in the treatment of melanomas.

Allowable Subject Matter

14.Claim 25 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

15.No claim is allowed.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J. Huff whose telephone number is (703) 305-7866. The examiner can normally be reached on Monday-Thursday from 6:30am to 3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lila Feisee, can be reached on (703)308-2731. The FAX phone number for this Group is (703)308-4242.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**lila.feisee@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. **PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122.** This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Sheela J. Huff
July 31, 1997

Sheela J. Huff
Patent Examiner
Group 1800